

REMARKS

Claim objections

Claim 5 has been noted as containing the “abnormality” “printer.” (i.e., the word “printer” followed by a period) on the second line from the end, when it should read “printer,” (i.e., the word “printer” followed by a command). Applicant has made the requested correction.

Claim rejections under 35 USC 102

Claims 1-3, 5-13, and 16-20 have been rejected under 35 USC 102(e) as being anticipated by Okada (2002/0018237). Claims 1, 5, and 18 are independent claims, from which the remaining claims ultimately depend. Applicant submits that as previously presented, claims 1, 5, and 18 are patentable over Okada, such that all the pending claims are patentable over Okada.

Applicant discusses claim 1 as representative of all the independent claims 1, 5, and 18, insofar as patentability over Okada is concerned. In particular, it is important to note the following. In the claimed invention, each “identified Internet enabled device” is notified of the “specific location for said saved facsimile,” “so that the identified Internet enabled device can later retrieve said facsimile from said specific location.” The notification is “made via a notification message . . . not containing said saved facsimile.”

Let us parse these limitations in some detail so that it is understood exactly the subject matter to which the claimed invention is limited. An Internet enabled device is notified that a saved facsimile is at a specific location. This notification is made via a notification message that does not actually contain the saved facsimile. The Internet enabled device can then later retrieve the saved facsimile from the specific location. It is noted that the Internet enabled device that is notified of the specific location of the saved facsimile is *the same Internet enabled device that can then retrieve the saved facsimile from the specific location later.*

Applicant submits that the claimed invention as described above is not anticipated by Okada. Applicant bases this contention on black letter law, in which anticipation requires “the disclosure in a single prior art reference of each element of the claim under consideration,” (W.L. Gore & Assocs. v. Garlock, Inc. 220 USPQ 303, 313 (Fed. Cir. 1983) “*arranged as in the*

claim.” (Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co. 221 USPQ 481, 485 (Fed. Cir. 1984)) In the present case, Applicant submits that Okada does not disclose the elements of the claimed invention “arranged as in the claim.” Specifically, Applicant submits that Okada does not notify an Internet enabled device as to the location of a saved facsimile, such that *this same* Internet enabled device can later retrieve the saved facsimile from this location.

Okada discloses a number of different embodiments. The only relevant embodiment as to the claimed invention is the “First Embodiment” described in paragraphs [0057] through [0071]. In other words, the other embodiments do not pertain to notifying an Internet enabled device that a facsimile has been received and stored at a specific location for later retrieval by the Internet enabled device. With respect to this first embodiment, Okada notes that “[a] description will be given of the network structure shown in FIG. 24.” (Para. [0057]) In FIG. 24, there are relevantly a NETFAX 212, a PC 211, and a printing machine 210.

Now, in Okada’s first embodiment, “NETFAX transfers the result of a reception of facsimile data, received from the PSTN, to a reception node on the LAN by e-mail.” (Para. [0066]) More specifically, “[i]n the NETFAX [of FIG. 1, the facsimile section 6 receives facsimile data from the PSTN . . . and temporarily stores the facsimile data in the facsimile data storage section 5.” (Para. [0068]) Then, “[w]hen one page or whole pages of facsimile data are saved . . . printing of image data is initiated” and “the facsimile reception process is terminated.” (Para. [0069]) Thereafter, the “result of the facsimile reception process is detected . . . a notification based on the process result . . . is determined” and “the notification message is [sent] by e-mail to the e-mail address of the reception node.” (Para. [0070])

Therefore, what is occurring in Okada’s first embodiment is that the NETFAX receives a facsimile, saves it in its data storage section 5, prints the facsimile on the printing machine 210, and once this entire process has been completed, emails the reception node – e.g., the PC 211 – that the facsimile has been received and printed on the printing machine 210. As such, a user at the PC 211 can “know when facsimile data has arrived and obtain it immediately upon arrival . . . to overcome such a problem that transmitted facsimile data does not reach the transmission destination for a long time.” (Para. [0071])

In this way, however, Okada's first embodiment is different than that which is claimed in the claimed invention. In the claimed invention, an "Internet enabled device" receives a notification message, such that *this same* "Internet enabled device" can later retrieve the facsimile from the specific location indicated in the notification message. But this is not what Okada does in its first embodiment. Rather, Okada prints a saved facsimile on a printing machine 210 – thus concluding what Okada calls the "facsimile reception process" – and then notifies the PC 211 with a notification message by email that this process has been finished. Nowhere in this first embodiment of Okada can this PC 211 "later retrieve the saved facsimile at the specific location." Of course, *the user* of the PC 211 can and likely will walk over to the printing machine 210 to pick up his or her fax, but the user is not the reception node, the PC 211 is. The PC 211 is never, in other words, able to later retrieve the saved facsimile from the specific location indicated in the notification message, unlike the claimed invention.

It is noted that, in addition to the PC 211, the printing machine 210 of Okada also cannot be considered as performing the same functionality as the Internet enabled device of the claimed invention. In the claimed invention, the Internet enabled device receives a notification message so that it can later retrieve a saved facsimile from the specific location indicated in the notification message. However, Okada first prints the facsimile on the printing machine 210, and then sends a notification to the Internet enabled device. The printing machine 210, even if it were construed to be the Internet enabled device of the claimed invention, does not later retrieve the saved facsimile from the specific location indicated in the notification message, since the printing machine 210 *already has received and has printed* the saved facsimile. For all of these reasons, therefore, Okada does not teach all the elements of the claimed invention "arranged as in the claim" as is required, and thus does not anticipate the claimed invention.

Applicant would also like to discuss paragraph [0071] of Okada, as the Examiner seems to suggest that this paragraph teaches some of the aspects of the claimed invention that have been discussed above. Paragraph [0071] is the concluding paragraph of the first embodiment that has been discussed above, in which a fax is received and printed on a printing machine, thus completing the facsimile reception process, and then a reception node is notified that the facsimile

reception process has been concluded, so that, for instance, the user at the reception node can go to the printing machine to pick up his or her fax. Understanding what paragraph [0071] means is thus useful.

Now, paragraph [0071] recites the following:

According to this embodiment, since the result of the facsimile reception process is notified to the reception node by e-mail, it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately upon arrival by facsimile, and to overcome such a problem that transmitted facsimile data does not reach the transmission destination for a long time.

The English of this paragraph is, quite frankly, a bit tortured, and therefore some interpretation of Okada has to be made in order to understand how one of ordinary skill within the art would consider what Okada discloses. (Applicant notes in this regard that Okada appears to have been translated from Japanese, insofar as it is a divisional patent application of another divisional patent application that was a US national stage filing of an international publication originally filed in Japanese – see field (62) of the first page of Okada, for instance.) For example, Okada discusses “the result of the facsimile reception process is notified to the reception node by e-mail,” but this is not proper usage of the term “notified.” You say “John is notified of an event,” for instance, not “the event is notified to John.” It appears in this first instance that Okada means to say that “the result of the facsimile reception process is *conveyed* to the reception node by e-mail,” instead of being “notified” to the reception node, which does not make much sense.

It is also important to understand what this “facsimile reception process” of paragraph [0071] of Okada entails. As has been described above, the “facsimile reception process” entails receiving a fax and printing it on a printing machine. That is, paragraph [0069] of Okada notes that “[t]hrough the processes from the reception of facsimile data to printing thereof, the facsimile reception process is terminated,” which seemingly suggests that once the facsimile data has been received and printed, the resulting facsimile reception process is finished. Therefore, the reception node in Okada is notified by e-mail of the result of the facsimile reception process – specifically that a fax has been received and has been printed on a printing machine.

Now, paragraph [0071] of Okada says that “[a]ccording to this first embodiment, since the result of the facsimile reception process is notified to the reception node by e-mail” (that is, the reception node is notified of the result of the facsimile reception process, which concludes upon printing of the received fax), “it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately upon arrival by facsimile.” Again, we have some tortured English to deal with in this paragraph. Okada says that “it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately upon arrival by facsimile.” Of course, what Okada means is that “it is possible to permit the reception node to know when the facsimile data has arrived and *for the user* to obtain it immediately upon *[its]* arrival by facsimile.”

This is an important distinction. The reception node *itself* cannot really obtain the facsimile data upon the facsimile data having arrived by facsimile in accordance with the conclusion of the facsimile reception process of Okada’s first embodiment. This is because the facsimile reception process, as described in detail in Okada in paragraphs [0066] through [0070], involves the NETFAX receiving a fax and printing it, and after the conclusion of this facsimile reception process, sending the reception node a notification by e-mail. The only way the reception node itself could “obtain [the fax] immediately” is for it to nonsensically walk over to the printing machine and pick up the hardcopy of the fax! It is clear, in other words, that in Okada’s tortured English, what Okada means is that *the user* of the reception node – not the reception node itself – can immediately obtain the facsimile, by walking over to the printing machine and pick up the hardcopy of the fax.

That is, where Okada in paragraph [0071] says that “[a]ccording to this first embodiment” described in paragraphs [0066] through [0070], “since the result of the facsimile reception process is notified to the reception node by e-mail” (that is, the reception node is notified of the result of the facsimile reception process), we have to look at what this facsimile reception process entails in interpreting what Okada then means when it says that “it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately.” The facsimile reception

process is described in Okada as receiving and printing a fax. It does not make sense to take Okada's statement that "it is possible to permit the reception node to know when facsimile data has arrived *and obtain it immediately*" in light of what the facsimile reception process actually is, since a reception node – i.e., a computer like a PC – cannot obtain something that has been printed out on paper.

That is, no different than you have to interpret Okada's saying that "the result of the facsimile reception process is notified to the reception node by e-mail" to mean that "the reception node is notified of the result of the facsimile reception process by e-mail" – since it is the reception node being notified of the result, not the result being notified of the reception node – you likewise have to interpret Okada's saying that "it is possible to permit the reception node to . . . obtain [the facsimile] immediately" to mean that "it is possible to permit *the user of the* reception node to obtain the facsimile immediately." Where Okada has been translated from the Japanese, in other words, we cannot fall into the trap of making a literal but nonsensical interpretation of Okada, but rather have to look to the whole of Okada to see what it actually discloses and teaches.

In this sense, Applicant refers the Examiner to the Federal Circuit decision *Paperless Accounting, Inc. v. Bay Area Rapid Transmit Sys.*, 804 F.2d 659, 231 USPQ 649, 653 (Fed. Cir. 1986). A prior art reference must be enabling under 35 USC 112, first paragraph. (804 F.2d at 665, 231 USPQ at 653) The description of a reference must enable a person with ordinary skill in the art to comprehend the invention as well as make it. (Id.) Here, we cannot take the words of paragraph [0071] of Okada at face value, since one of ordinary skill within the art would not be able to *comprehend*, nor make, the invention of Okada as the words of paragraph [0071] suggest at face value. Rather, understanding that Okada is a somewhat poor English translation of a patent application originally filed in Japanese, we have to interpret paragraph [0071] properly in the same way that one of ordinary skill within the art would to make the invention that Okada teaches in the foregoing paragraphs [0066] through [0070].

To conclude, Applicant would like to cite no less an authority than Irah H. Donner's seminal work, "Patent Prosecution: Law, Practice, and Procedure" (4th ed., vol. I), in which Mr. Donner notes the following:

The Examiner must provide a reasonable basis for stating that a prior art reference under Subsection 102(a), (b), (d), (e), or (g) sufficiently describes the subject matter therein to place the subject matter in the public domain. Thus, if an Examiner's assertion that the reference adequately describes the subject matter to place it in the public domain is unreasonable or outrageous, an applicant can attack this element of anticipation to prevent the prime face case of anticipation. If the reference does not teach, no anticipation can be found.

(Ch. 7.V.B, p. 952) Here, Okada does not actually *teach* a reception node obtaining a facsimile after it has received notification that a facsimile has been received and printed. Rather, what Okada actually *teaches* is that a facsimile is received and printed, and then a reception node is notified of this fact. Therefore, even though paragraph [0071] of Okada says that a reception node obtains a facsimile after the facsimile has been printed, what Okada actually means – and what Okada actually teaches – is that a user of the reception node can obtain the facsimile after it has been printed and the reception node has received an email to that effect. This is especially true here, where it appears that Okada has been translated (poorly) to English from Japanese, and where to make sense of other parts of its disclosure – including the very first part of paragraph [0071], as has been discussed above – we also have to decipher what Okada means instead of what at face value it says.

Respectfully Submitted,



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